

Appl. No. 10/622,048
Reply Dated August 12, 2005
Reply to Office Action of June 28, 2005

Docket No. CM05154H
Customer No. 22917

REMARKS/ARGUMENTS AFTER FINAL

Claims 1-19 remain in the application. Reconsideration of this application is respectfully requested in light of the remarks that follow.

1. **REAL PARTY IN INTEREST**

The name of the real party in interest for purposes of this appeal is Motorola, Inc., a Delaware corporation.

2. **STATUS OF CLAIMS**

These remarks are in response to a second Office Action (marked final) dated June 28, 2005. Claims 1-19 remain in the application. In the second Office Action (marked final) dated June 28, 2005, the Examiner rejected Claims 1-8 and 12-14 under 35 U.S.C. § 103 as being unpatentable over Wejke, et al. (USPN 5,175,867 A) in view of Rom (USPN 6,360,264 B1), further in view of Crosbie (US 2002/0085719 A1). Further, Claims 15-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wejke, et al. (USPN 5,175,867 A) in view of Rom (USPN 6,360,264 B1).

No claims have been allowed. The claims have been reproduced above.

3. **STATUS OF AMENDMENTS**

No amendments have been made to the application.

4. **SUMMARY OF CLAIMED SUBJECT MATTER**

Novel methods for performing seamless handoff from one access point (AP) to another AP in a communication system are proposed by Applicants. A demonstration of this innovation is exemplified in Applicant's specification and is described as improving performance by adding additional AP processing and inter-AP messaging to the handoff procedure that provides for a more seamless handoff for mobile stations. This improvement is described in the specification at a number of places but explicitly on page 3 and in element 206 of FIG. 2. In particular,

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Applicants' claimed invention requires "sending a disassociation message to the mobile station to disassociate with the first access point, wherein the disassociation message is addressed as if it originated from the first access point" which is not found in the cited art.

5. ARGUMENT

Claims 1-8 and 12-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wejke, et al. (USPN 5,175,867 A) in view of Rom (USPN 6,360,264 B1), further in view of Crosbie (US 2002/0085719 A1). Further, Claims 15-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wejke, et al. (USPN 5,175,867 A) in view of Rom (USPN 6,360,264 B1).

A. The references cited in rejecting Applicants' claimed invention are an improper basis for rejection.

The Examiner correctly states Wejke is limited to disclosing handoff within a *cellular* communications system. As such, a cellular communications system does not comprises access points whereas access points are limitations of Applicants' claimed invention. Because Wejke is limited to disclosing handoff within a *cellular* communications system and Applicants' claimed invention is not directed to a *cellular* communications system but is limited to "access points," Wejke is a defective basis for rejection under 35 USC 103.

The Examiner states that it would have been obvious to one of ordinary skill in the art to utilize access points (as described in Rom) instead of base stations, but such an assertion is defective. First, such an assertion is defective because there must be a basis in the art to combine Wejke with Rom. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1999). The Federal Circuit has held that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *ACS Hospital Systems, inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). In this case, there is no basis, teaching, suggestion, or incentive in either Wejke or Rom (even without considering Crosbie) to combine the two references. Thus, the rejection under 35 U.S.C. § 103 should be withdrawn.

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Second, such an assertion is defective because the references are not properly combinable if combining the references destroys the intent, purpose or function of the invention disclosed in the reference. See, *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In theory, access points may be compared with base stations as noted in the Rom reference (as cited by the Examiner); however, in practice such a comparison fails. As noted by Rom (and not cited by the Examiner), the techniques used by cellular telephone systems are inadequate to accomplish handoff with access points since access points must manage high data rates. Rom, col. 2, lines 42-62. Thus, combining the two references, one relating to cellular telephone systems and the other relating to wireless local area networks with access points, destroys the intended function of each. Specifically, combining the handoff technology of Wejke with the access points of Rom destroys the functionality of high data rates in the wireless local area network of Rom. As such, Wejke can not be combined with Rom (even without considering Crosbie). Thus, the rejection under 35 U.S.C. § 103 should be withdrawn.

B. A claimed limitation is missing from the cited references.

MPEP § 2141.03 requires that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Regarding Claims 1-19, the limitation to sending/transmitting "a disassociation message to the mobile station, wherein the disassociation message is addressed as if it originated from the first access point," is not taught or suggested by the cited references, so the rejection is unsupported by the art and should be withdrawn. The Examiner correctly states that this limitation is not found in either Wejke or Rom and attempts to use Crosbie to fill this voice. However, the Examiner misreads Crosbie for the teaching of "disassociation message." The Examiner correctly notes that Crosbie teaches the reassignment of session data from one access point to a second access point. Specifically, Crosbie teaches sending data packets to the target or secondary access point via spoofing (e.g. Crosbie, paragraph 57); however, such a teaching can not be read so broadly to encompass Applicants' claimed limitation to sending/transmitting "a disassociation message." As such, such a limitation is missing from Crosbie. Thus, the rejection under 35 U.S.C. § 103 should be withdrawn.

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6. CONCLUSION

For the above reasons, Applicants respectfully submit that the rejection of Claims 1-19 is in error and that the claims be allowed. Accordingly, this application is believed to be in proper form for allowance and an early notice of allowance is respectfully requested.

Respectfully submitted,

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